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Docket No. F-8518

Mail Stop PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Takashi IKI, et al.
Serial No. : 10/518,986
Filed : December 21, 2004
For : PAPER FEED ROLLER AND FABRICATION
METHOD THEREOF
Group Art Unit : UNKNOWN
Examiner : UNKNOWN
Confirmation No. : 7021
Customer No. : 000028107

Certificate of Mailing Under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop PCT, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450 on January 10, 2008.

Ricardo Unikel
(Name)

Ricardo Unikel
(Signature and Date)

01/10/08

MAIL STOP PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R §1.8(b)

Sir:

Applicants hereby petition that the attached Response to Communication be considered timely filed and be acted on by the USPTO.

01/15/2008 LLANDGRA 00000026 10518986

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f8518 pet 1-8(b) {PC04 }.wpd

On March 13, 2007, the USPTO issued a Communication. On August 10, 2007 Applicants filed a Response to Communication along with the appropriate request for an extension of time. The USPTO received the Response to Communication but appears to have misplaced it after its receipt.

Under 37 C.F.R. § 1.8(b), such situation can be remedied by doing the following as delineated in 37 C.F.R. § 1.8(b)(1)-(3):

- (1) Informing the USPTO of the previous mailing or transmission of the correspondence promptly after becoming aware that the USPTO has no evidence of receipt of the correspondence;
- (2) Supplying an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Including a statement that attests to the previous timely mailing, transmission or submission.

Regarding (1), the present Petition informs the USPTO of the previous mailing. Applicants' attorneys became aware of the present situation within the previous two months.

Regarding (2), a copy of the previous submission (Response to Communication) is attached herewith.

Regarding (3), the Response to Communication was received by the USPTO on August 10, 2007 and enclosed is a copy of the postcard showing receipt by the USPTO on that date.

Accordingly, Applicants respectfully request that the attached Response to Communication be considered timely filed and be acted on by the USPTO.

No fees are believed due for the present Petition. However, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Respectfully submitted,

Jordan and Hamburg LLP

By Frank J. Jordan
Frank J. Jordan
Reg. No. 20,456
Attorney for Applicants

BW and,

By Ricardo Unikel
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FJJ/RU/cj
Enc. Copy of postcard dated August 10, 2007

Response to Communication dated August 10, 2007



Docket No. F-8518

Serial No. 101518986

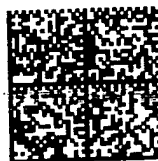
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The date stamp of the Patent Office hereon may be considered as the date on which papers indicated below were received.

New Application	<input type="checkbox"/>	Dec./Power of Att.	<input type="checkbox"/>
RCE	<input type="checkbox"/>	Assignment	<input type="checkbox"/>
Supplemental Amendment	<input type="checkbox"/>	Priority Document	<input type="checkbox"/>
Preliminary Amendment	<input type="checkbox"/>	IDS/IDC	<input type="checkbox"/>
English Translation App.	<input type="checkbox"/>	Notice of Appeal	<input type="checkbox"/>
Marked Specification	<input type="checkbox"/>	Appeal Brief	<input type="checkbox"/>
Substitute Specification	<input type="checkbox"/>	Issue Fee	<input type="checkbox"/>
Letter to Draftsman/Drawings	<input type="checkbox"/>	Statement of Use	<input type="checkbox"/>
Resp. to Examiner <u>of 3/13/07</u>	<input type="checkbox"/>	Section 8 and	<input type="checkbox"/>

IAP6 Rec'd PCT/PTO 10 AUG 2007

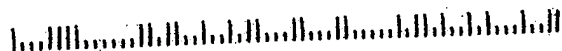
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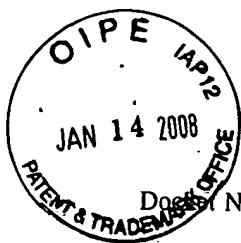


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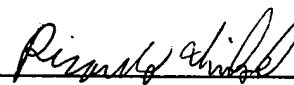
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Ricardo Unikel
(Name)


(Signature)

MAIL STOP PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO COMMUNICATION

Sir:

Applicants submit this Response to Communication in the above-mentioned application in response to the Communication of March 13, 2007 from the U.S. Patent and Trademark Office (USPTO).

The Communication of March 13, 2007 states that the Declaration filed in the above-identified application is defective for the following reasons: 1) Mr. Oosaki (a deceased inventor) did not sign the declaration and neither did his legal representative. The absence of the signature of the legal representative has not been properly excused. 2) The Declaration is not accompanied by a verification of the translation into the English language.

MPEP § 1893.01(e) states that the requirement for an oath or declaration in compliance with 37 C.F.R. § 1.497(a)-(b) will have been previously satisfied if a declaration in compliance with PCT Rule 4.17(iv) and executed by all the inventors was appropriately submitted during the international phase. It is Applicants' position that such a Declaration was indeed submitted during the international phase and that therefore the requirement for an oath or declaration in compliance with 37 C.F.R. § 1.497(a)-(b) has been satisfied. Accordingly, it is Applicants' position that no additional oath or declaration is required.

On August 3, 2007, Applicants' attorney, Ricardo Unikel, spoke with PCT Legal Examiner George Dombroske and explained the situation regarding the PCT Rule 4.17(iv) Declaration. Mr. Dombroske provided the following guidance:

- 1) A PCT Rule 4.17(iv) Declaration is sufficient to fulfill the requirement for an oath or declaration in the U.S. and must be submitted along with a verified English translation.
- 2) There must be some indication that the inventors knew the patent application for which they were signing the Declaration. Such indication is shown, for example, by a specific reference in the Declaration itself to the PCT application.
- 3) The USPTO can get information from the International Bureau as to whether the PCT Rule 4.17(iv) Declaration was filed.

As to 1), please find attached a PCT Rule 4.17(iv) Declaration along with a verified English translation. Such Declaration was filed during the international phase.

As to 2), attention is directed to the first page of the Declaration where there is a specific reference to PCT/JP02/11181, which is the PCT application for which the above-identified U.S. application is a national stage entry thereof.

As to 3), Applicants note that the front cover of WO 2004/007324 (the publication of PCT/JP02/11181) contains a reference to a PCT Rule 4.17(iv) Declaration. Since the USPTO can obtain the relevant information for this PCT Rule 4.17(iv) Declaration, no copy of the front cover of WO 2004/007324 is provided herewith with an English translation of the relevant portion.

In light of the above, it is Applicants' position that the requirement for the submission of an oath or declaration in the above-identified U.S. Patent Application has been fulfilled and respectfully request that notice be provided to that effect and that the above-identified U.S. Patent Application be forwarded for examination by the USPTO.

Applicants respectfully request a three month extension of time for responding to the Office Action. **The fee of \$1020.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO

F-8518

Ser. No. 10/518,986

is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Respectfully submitted,

Jordan and Hamburg LLP

By Frank J. Jordan
Frank J. Jordan
Reg. No. 20,456
Attorney for Applicants

R and,

By Ricardo Unikel
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Reg. No. 52,309
Attorney for Applicants

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(212) 986-2340

Enc. PCT Rule 4.17(iv) Declaration and verified English translation
Credit Card Payment Form PTO-2038

VIII-4-1	発明者である旨の申立て（米国を指定国とする場合） 発明者である旨の申立て（米国を指定国とする場合）（規則4.17(iv)及び51の2.1(a)(v)）	私は、特許請求の範囲に記載され、かつ特許が求められている対象に関して、自らが最初、最先かつ唯一の発明者である（発明者が1名しか記載されていない場合）か、あるいは共同発明者である（複数の発明者が記載されている場合）と信じていることを、ここに申し立てる。 本申立ては、国際出願PCT/JP02/11181を対象としたものである（規則28の3に従って申立てを提出する場合）。
		私は、特許請求の範囲を含め、上記国際出願を検討し、かつ内容を理解していることを、ここに表明する。 私は、PCT規則4.10の規定に従い、上記出願の願書において主張する優先権を特定し、かつ、「先の出願」という見出しの下に、出願番号、国名又は世界貿易機関の加盟国名、出願日、出願月、出願年を記載することで、米国以外の少なくとも一国を指定しているPCT国際出願を含め、優先権を主張する本出願の出願日よりも前の出願日を有する、米国以外の国で出願された特許又は発明証の出願をすべて特定している。
VIII-4-1	先の出願：	
		私は、連邦規則法典第37編規則1.56 (37C.F.R. §1.56) に定義された特許性に関し重要であると知った情報について開示義務があることを、ここに承認する。さらに、一部継続出願である場合、先の出願の日から一部継続出願のPCT国際出願日までの間に入手可能になった重要な情報について開示義務があることを承認する。 私は、表明された私自身の知識に基づく陳述が真実であり、かつ情報と信念に関する陳述が真実であると信じていることをここに申し立てる。さらに、故意に虚偽の陳述などを行った場合は、米国法典第18編第1001条に基づき、罰金、拘禁、又はその両方により処罰され、またそのような故意による虚偽の陳述は、本出願又はそれに対して与えられるいかなる特許についても、その有効性を危うくすることを理解した上で陳述が行われたことを、ここに申し立てる。

Okamura Patent Office

Original (for application)

VIII-4-I	<p>Declaration that the applicant is the inventor (in cases where U.S. is designated)</p> <p>Declaration that the applicant is the inventor (in cases where U.S. is designated) (Rule 4.17 (iv) and 51-2.1(a)(iv))</p>	<p>I hereby declare that I believe I am the original, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.</p> <p>This declaration is directed to International Application PCT/JP02/11181 (if furnishing declaration pursuant to Rule 26-3).</p> <p>I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application.</p> <p>I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading "Prior Applications," by application number, country or Member of the World Trade Organization, day, month and year of filing, any application for a patent or inventor's certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed.</p>
VIII-4-1-1	Prior application:	<p>I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p>

Original (for application)

VIII 4-1-1-1 VIII-4-1-1-2 VIII-4-1-1-3	Name: Address: (city, state in the U.S. (if applicable) or country) Mailing address	Takashi IKI Kyoto-shi, JAPAN c/o Suncall Coporation 14, Umezunishiuracho, Ukyo-ku, Kyoto-shi, Kyoto, JAPAN 615-0917
VIII-4-1-1-4	Nationality	JP
VIII-4-1-1-5 VIII-4-1-1-6	Inventor's signature (In cases where the international application is not signed by the inventor, or claims were supplemented/added after filing of the international application subject to the Rule 26-3. The signature shall be made by the inventor not by an agent.) Date: (In cases where the international application is not signed by the inventor, or claims were supplemented/added after filing the international application subject to the Rule 26-3.)	[Signed by Takashi IKI] October 24, 2002
VIII 4-1-2-1 VIII-4-1-2-2 VIII-4-1-2-3	Name: Address: (city, state in the U.S. (if applicable) or country) Mailing address	Kazuhiro OOSAKI Kyoto-shi, JAPAN c/o Suncall Coporation 14, Umezunishiuracho, Ukyo-ku, Kyoto-shi, Kyoto, JAPAN 615-0917
VIII-4-1-2-4	Nationality	JP
VIII-4-1-2-5	Inventor's signature (In cases where the international application is not signed by the inventor, or claims were supplemented/added after filing the international application subject to the Rule 26-3. The signature shall be made by the inventor not by an agent.)	[Signed by Kazuhiro OOSAKI]
VIII-4-1-3-6	Date: (In cases where the international application is not signed by the inventor, or claims were supplemented/added after filing the international application subject to the Rule 26-3.)	October 16, 2002

DECLARATION

I, Iori Joko, a citizen of Japan, residing at 133 Seaman Ave. #1A, New York, NY, USA, do hereby declare under Section 1001 of Title 18 of the United States Code that I am conversant with the English and Japanese languages and am a competent translator thereof, and that to the best of my knowledge and belief the attached is a true and correct English translation of the enclosed original Japanese document executed by Takashi IKI on October 24, 2002 and by Kazuhiro OOSAKI on October 16, 2002.

On this day of

Aug 9, 2007

Iori Joko
Iori Joko